

No. 9871

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IN THE
United States Circuit Court of Appeals
For the Ninth Circuit

SIMPLEX WRAPPING MACHINE CO.

(a corporation),

Appellant,

vs.

CHARLES F. SCHULTZ, IRA E. SCHULTZ,
SCHULTZ FOOD COMPANY (a partner-
ship), and GEORGE KOSTER, doing
business under the fictitious name
and style of Koster Candy Company,
Appellees.

Upon Appeal from the District Court of the United States for the
Northern District of California, Southern Division.

REPLY BRIEF FOR APPELLANT.

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REPLY BRIEF FOR APPELLANT.

GENERAL REMARKS.

This reply brief will be confined mainly to the points raised in Defendants' (Appellees') brief, and it will be shown that Defendants have not properly rebutted the points raised in Plaintiff's opening brief.

**GENERAL NATURE OF ARGUMENTS PRESENTED IN
DEFENDANTS' BRIEF.**

Defendants argue in general that the lower Court was correct in holding the claims in suit to be anticipated by the prior art. They also urge invalidity because of the wording of certain of the claims, and because claim 14 is alleged to be an improper method claim.

Although the trial Court made no findings or conclusions with respect to infringement, Defendants devote a considerable part of their brief to lack of infringement, assuming that the claims are valid.

An unusual phase of Defendants' brief is worth noting. On pages 25, 26 and 27 of Plaintiff's brief it is pointed out that the combination of claim 3, including the retractable fold line retaining means, is novel over the showing of the prior art, and that its novelty and utility was specifically conceded by the testimony of the Defendant Charles F. Schultz (Tr. p. 298).

Now Defendants are specifically contradicting the testimony of Charles F. Schultz, and they purport to find the combination of claim 3 in the Hotchkiss and Hesser patents, including particularly the retractable fold line retaining means (Defendants' Brief pp. 9, 12, 13, 21). This clearly reveals a lack of reasonable restraint in urging invalidity, and in belittling Gaubert's patented contribution to the art of making moistureproof cellophane bags.

In addition to the above, Defendants have gone beyond the actual record by contending that the latest model (Plaintiff's Exhibit 6) Simplex machine has

borrowed many mechanical features from the Defendants' machine.

VALIDITY—PRIOR ART IN GENERAL.

Commencing on page 7 of their brief Defendants call attention to two Supreme Court decisions, namely *Machine Company v. Murphy*, 97 U.S. 102, and *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U.S. 405. Presumably Defendants intend to have this Court take judicial notice of the fact that bag machines are notoriously old in the art, with the inference that no such present day patent can be valid.

In both of the above Supreme Court decisions the patents in question were held valid and infringed, although admittedly covering only improvements to prior machines for making bags. They also held that the claims should not be strictly construed, but should be given a reasonable interpretation with respect to the range of mechanical equivalents covered.

Plaintiff in this instance is certainly entitled to treatment as equitable as accorded by the Supreme Court in the above cases. There should be no arbitrary numerical limit to the number of real improvements which can be made in the art. No one can contend today that inventive genius is exhausted and that no further advances can be made.

On page 38 of Plaintiff's brief it was pointed out that Gaubert's invention supplied a long felt need in the food industry, and that this need had not been fulfilled by all of the paper bag machines previously de-

veloped in the art. Defendants submitted no evidence to controvert these facts, nor has the sufficiency of Plaintiff's evidence on this point been rebutted or even questioned.

Our patent laws were designed to encourage the making of improvements in arts which may seem to be stagnant. It is fully as important to make new and improved machines in old fields as to pioneer a new industrial field.

PRIOR ART—THE HOTCHKISS PATENT.

On page 9 of their brief, Defendants analyze the Hotchkiss patent and purport to find "all of the essential elements of the Gaubert patent, except for the heat sealing". This statement is surprising when it is considered that at the trial Defendants presented no evidence whatsoever with respect to the disclosure of Hotchkiss patent.

Defendants also purport to find in the Hotchkiss patent a retractable fold line retaining member, in spite of the fact that this contention is flatly contradictory to the evidence of Defendants' expert, Charles F. Schultz (Tr. p. 298). Schultz professed that he had the qualifications of an expert, and that he was familiar with all of the prior art patents relied upon (Tr. p. 266). With these qualifications he testified about the fold line retaining means as quoted on page 26 of Plaintiff's Opening Brief.

Therefore, at the time of trial it was the opinion of Charles F. Schultz that the prior art failed to show

“a fold line retaining means in conjunction with a mandrel in a machine for making bags”. If Defendants’ expert at the time of trial was unable to find this disclosure in the Hotchkiss patent, how can this Court at the present time be expected to find this structure in Hotchkiss? Actually the Hotchkiss patent totally fails to show anything equivalent or similar to Gaubert’s retractable fold line retaining means. Hotchkiss folds his paper about box-like forms J, shown in his Figure 1 (Tr. p. 438). There are two of these forms, so that two bags are formed simultaneously. The paper is first wrapped around the sides of these forms and then projecting end portions of the paper are interfolded, the same as one would place a paper wrapper about a box and then interfold the end of the wrapper. This forms a square bag with an interfolded bottom.

Defendants call particular attention to the members m’ shown in Figure 2 (Tr. p. 440), which are used to carry out part of the end folding operation. Hotchkiss simply points out that these end folding members remain in place until the final end folds are made, and are then automatically withdrawn (Tr. p. 450, col. 2, lines 45-50).

The Gaubert machine is totally different from Hotchkiss. In the first place, Gaubert is dealing with a machine having a flat mandrel about which the cellophane is folded to make a flat bag (Tr. p. 134). Gaubert’s fold line retaining means is a separate mechanism which works in conjunction with means for folding over the side margins of the sheet of material

over the mandrel, and means for folding the projecting end margin of the sheet over the end of the mandrel to form the bottom of the bag (Tr. p. 334, col. 2, line 75 to p. 335 col. 1, line 28).

Defendants contend that in Hotchkiss the member which holds down a fold must be construed to be a retractable fold line retaining means. No reason is seen why such a presumption should be made, particularly because the evidence is to the contrary. Actually any layman will appreciate that a fold can be held down generally, without specifically establishing and retaining a definite fold line for a successive folding operation.

Charles F. Schultz himself admitted that if the special fold line retaining bar on his machine were taken off, the machine would not operate satisfactorily, but would be subject to wrinkling of the sheet (Tr. p. 298), in spite of the fact that his machine is provided with means for holding down the side folds. Thus the disclosure of Hotchkiss would not have been helpful to Defendants.

Defendants admit that Hotchkiss does not show heat sealing means in conjunction with the other elements, although it is inferred that the heat sealing means might be readily incorporated (Defendants' Brief p. 10). Here, again, there is no testimony of record with respect to the way in which one might re-build the Hotchkiss machine to incorporate heat sealing means, and particularly the use of a T-shaped heater. The only presumption actually warranted in this connection is that a complete re-organization and re-building

of the Hotchkiss machine would be necessary to incorporate heat sealing and to make flat bags, and such re-building would be entirely beyond the skill of an ordinary mechanic.

PRIOR ART—BEYER PATENT.

Beginning on page 10 of Defendants' brief this patent is analyzed, and the unwarranted conclusion drawn that operation of the machine is almost exactly the same as the Gaubert machine. Plaintiff, beginning with page 9 of his brief, under the title "The Prior Art Patents", points out the differences between the Gaubert patent and Beyer. Even Defendants must admit that the Beyer patent is useless for the manufacture of heat sealed cellophane bags. Defendants fail to properly rebut the distinctions over Beyer pointed out in Plaintiff's brief, and which are amply supported by the evidence of record (Plaintiff's Opening Brief pp. 9-12 inc.).

In outlining different elements shown by the Beyer patent, on page 10 of their brief, Defendants state that Beyer shows "pressure means for effecting this seal". As properly pointed out in Plaintiff's opening brief (p. 10), in Beyer pasting devices apply glue or paste to the edges of the sheet of paper, so that the overlapping edges are caused to adhere together after the folding operation. No separate device is incorporated in the machine for applying pressure, except that when the folding devices are operated, the overlapping edges may be retained in engagement to cause the paste or glue to properly adhere.

Beyer's machine does not operate "exactly the same as the operation of the Gaubert machine", because as properly pointed out in Plaintiff's opening brief (p. 11), it cannot be used to fold a sheet of paper which does not have cutaway corners to provide an end tab, there is no heat sealing operation nor means to perform such an operation, there is no retractable fold line retaining means in addition to the folding devices, and the machine is incapable of producing a heat sealed cellophane bag corresponding to the bags produced upon both Plaintiff's and Defendants' machines.

PRIOR ART—HUNT PATENT.

Beginning near the bottom of page 11, Defendants in their brief discuss the Hunt patent, and conclude that it shows Gaubert's process of heat sealing. This patent was discussed commencing at the bottom of page 12 of Plaintiff's brief. Plaintiff pointed out that in the Hunt patent wax paper is wrapped around a block of wood, instead of a flat plate, and that an L-shaped heater is used to seal both the bottom folds and the longitudinal side seams. Defendants mention (p. 12) that Figure 6 of Hunt "even shows the T shape exclusively dwelled upon in the Gaubert patent". As properly pointed out by Plaintiff's expert (Tr. p. 246), (and not controverted by Defendants), Figure 6 shows simply a back face of the heater which actually was not used by Hunt. Hunt used the two inner faces which are at right angles to each other, and which are intended to engage the interfolded bottom and the side of the bag.

Defendants have not contested the distinction over Hunt pointed out on pages 15 and 16 of Plaintiff's opening brief, where it is explained that Hunt's procedure is not capable of producing a bag from moistureproof cellophane without impairing the important moistureproof properties of the finished product.

THE PRIOR ART—HESSER PATENT.

Under this heading on page 12 of their brief, Defendants interpret the Hesser patent in substantially the same manner as Hotchkiss. Here, again, it is contended that Hesser shows "retractable fold line retaining means" constituting the "full equivalent of the Gaubert fold line retaining members 62a and 62b". Here, again, Defendants are departing from the record of this case, and they propose to contradict the testimony of Charles F. Schultz (Tr. p. 298).

Obviously Defendants must be bound by their testimony. Hesser (Tr. p. 472, p. 479, line 105), the same as Hotchkiss, merely provides inner folders 101 which hold the initial fold until the second fold is made upon the bottom of a square bag. Furthermore, Hesser, the same as Hotchkiss, does not incorporate retractable fold line retaining means as a separate mechanism operating in conjunction with side folding means and end folding means.

THE PRIOR ART—JOHNSON PATENT.

This patent is considered on page 13 of Defendants' brief, and was considered on page 18 of Plaintiff's brief. It shows no parts of a machine, except a block about which the paper is folded, and a table having a recess or slot to receive the block. Johnson (Tr. p. 485) forms a square bag, and the sides are interfolded to form two longitudinal seams which are then pasted or glued together. There is not even a superficial similarity to Plaintiff's machine and method.

THE PRIOR ART—CORSE PATENT.

This patent is considered on page 14 of Defendants' brief and was described near the bottom of page 18 of Plaintiff's opening brief. Briefly, Corse (Tr. p. 491) does not show either Gaubert's method of folding or heat sealing. The material is folded to form a square bag, with an interfolded bottom. Sealing is carried out in two operations using two separate heaters, one being for the longitudinal seam, and the other for the sealing operation. In general, the patent is quite similar to Hunt.

THE PRIOR ART—BECKER PATENT.

The Becker patent (Tr. p. 495) referred to near the bottom of page 14 of Defendants' brief, is considered on pages 16 and 17 of Plaintiff's opening brief. Defendants appear to agree that Becker's method and machine are quite different from Gaubert's machine.

However, Defendants erroneously state (p. 15) that the bags made by the Becker machine are substantially similar to bags made by the Gaubert machine. The record shows that heat sealing of the bottoms of the bags according to Becker fuses together all of the layers of the cellophane (Tr. p. 496, lines 14-23). Therefore, when the Becker bag is filled, there is a closed tab at the lower end of the bag where all of the layers of the cellophane have been heat sealed together (Tr. p. 254-255). No such heat fused tab is present in the bags made by the Gaubert machine, nor with Defendants' machine (Exhibits 8 and 15).

Defendants also fail to point out that the tubular material used in the Becker patent is material which has been previously formed into a flat tube and glued along its longitudinal seam. Thus, Becker uses part glueing and part heat sealing (Tr. p. 253, 495).

**VALIDITY OF SPECIFIC CLAIMS IN SUIT
CLAIM 2.**

Commencing on page 15 of Defendants' brief, claim 2 is considered in detail, and Defendants contend that this claim is anticipated particularly by the Beyer patent. Plaintiff's opening brief (pp. 21-23) dealt specifically with claim 2 (grouped with claims 5, 18 and 19) and pointed out lack of anticipation.

Defendants argue that because it is possible to find side and end folding elements in Beyer, together with a plate-like mandrel over which paper is folded, Gaubert's contribution to the prior art as defined by claim

2 is merely a heat sealer. Arguments of this character totally ignore the fact that when Gaubert incorporated heat sealing means together with the other elements of the machine, as defined by claim 2, a new machine or working combination of mechanical parts was formed. It is this new working combination which constitutes the subject matter defined by claim 2, and not simply the heater itself. The two pasting devices J of Beyer are not mechanically equivalent to a heat sealing heater because these devices do not perform substantially the same function in substantially the same way (Walker on Patents, Deller's Edition, p. 1703). A heat sealer works by applying heat and pressure after folding. Beyer's two pasting devices operate by applying glue or paste to the edges of the sheet of paper before the paper is folded.

It is unfair to make a nebulous general comparison between heat sealing and glueing, simply because they both form a seam. We are not dealing here with equivalency of general results, but we are concerned with mechanical equivalency with respect to devices for performing certain functions.

On page 20 Defendants' brief alleges that claim 2 is invalid because of the doctrine of the *Supreme Court in Bassick Manufacturing Co. v. Hollingshead*, 298 U.S. 415. In substance their argument is that because several of the elements recited in claim 2 are found in the Beyer patent, the claim endeavors to repatent the Beyer machine.

Defendants' argument based upon the Bassick decision is clearly in error. Actually that case involved

a question of contributory infringement. The patent claim defined apparatus including a high pressure grease gun and an improved special type of coupler adapted to seal upon the so-called "alemite" fitting (which was separately patented). The Supreme Court held that it was not contributory infringement of the patent claims to manufacture a fitting which could be used with the patentee's patented coupler, or to manufacture a grease gun and coupler which did not specifically infringe the patentee's coupler claims, but which could be used with the Plaintiff's patented fitting. No patent claims were held to be invalid.

In the present case there is no issue with respect to contributory infringement. The Defendants are here charged with direct infringement by the manufacture, use and sale of the complete machine (Tr. p. 3).

As previously stated, claim 2 specifies a combination consisting of several mechanical elements. The mere fact that some of these elements can be found in prior art patents, such as Beyer, is of no moment, because it is generally presumed that individual elements of a patented combination may be old by themselves. This was true, for example, of the patent claims considered by the Supreme Court in *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U.S. 405.

(See claims in footnote, 210 U.S. 417.)

Out of the patented combination, the Court found that the inventor had contributed a new feature which it described as follows:

“ ‘The pith of the invention’, the Circuit Court said, ‘is the combination of the rotary cylinder with means of operating the forming plate in connection therewith, limited, however, to means which cause the plate to oscillate about its rear edge.’ ”

THE CLAIMS IN SUIT—CLAIM 3.

Beginning on page 21, Defendants analyze claim 3 of the Gaubert patent, and argue that the subject matter of this claim is anticipated by Beyer, Hotchkiss and Hesser, and that the addition of retractable fold line retaining means to the machine of Beyer would not amount to invention.

Plaintiff’s opening brief (pp. 24 bottom of page through 28) adequately considered this claim and explained its novelty and utility. Particularly, it was pointed out that the combination included a novel element “retractable fold line retaining means adapted to be interposed within the last mentioned fold”, and that the novelty and utility of this element had been specifically admitted by the Defendants’ expert Charles F. Schultz.

Here, again, the elements of claim 3 must be considered as forming a distinct entity when taken in combination, namely a complete working organization of elements constituting a new machine.

As pointed out on page 4 of this brief, Defendants now blandly contend that Hotchkiss and Hesser show fold line retaining means, in direct contradiction to the testimony of Charles F. Schultz.

The mental processes of Defendants in making such contradictory contentions are not difficult to understand. It must be assumed that Charles F. Schultz testified to the best of his ability at the time of trial, and at that time he honestly believed that Hotchkiss and Hesser did not disclose retractable fold line retaining means, even though he had given these patents careful study. After considering Plaintiff's opening brief, the weakness of their position because of their appropriation of this feature, became apparent. Therefore, they are now making a last minute effort to find additional things in the prior art, including particularly the retractable fold line retaining means.

It is elemental that before a particular mechanical combination can be said to be disclosed in the prior art, the disclosure must be apparent to one skilled in the art (Walker on Patents, Dellar's Edition, p. 270). Certainly Defendants cannot now contend that a hypothetical person skilled in the art would find more in Hotchkiss and Hesser than the Defendants' expert Charles F. Schultz at the time of trial, after careful study of these patents. What was not obvious to Mr. Schultz at that time would not be obvious to others, particularly in view of his admitted interest as a defendant.

On pages 4 and 9 of this brief, Plaintiff has explained that Hotchkiss and Hesser do not disclose anything more than the use of a retractable folding element which remains in place to hold down a fold, while successive folds are being made over the top of the first fold. This mechanism is used in machines for

making square bags with interfolded bottoms. Defendants' machine uses folding means to fold over the side and end margins of the material to form a flat bag on a flat plate-like mandrel, but this folding means is admittedly not sufficient to establish the necessary fold line for the bottom of the bag (Tr. p. 298), even though the side folds are retained in place during the making of the end fold. It is necessary to have an additional retractable fold line retaining means, as a separate element forming a part of the working organization (Tr. pp. 92, 93).

Page 22 of Defendants' brief, it is argued that the recitation of fold line retaining means in claim 3 is sufficiently broad to cover even a ruler operated manually, and that recitation of this element is not such as to form anything else than an aggregation. The decision of *Powers-Kennedy Corp. v. Concrete M. S. C. Co.*, 282 U.S. 175, obviously does not support such an argument. In that instance the apparatus for conveying concrete was substantially old in the art, except that in the prior art it was used to transport material other than concrete. The Court held that such a new application would not support valid patent claims.

To repeat, claim 3 must be considered as an organization of mechanical elements, forming a working combination new in the art. Also note that this claim is quite similar to the claims before the Supreme Court in *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U.S. 405, which were held to be valid and infringed. In that instance the Court

properly pointed out that the claims were not merely drawn to a function (p. 422):

“The distinction between a practically operative mechanism and its function is said to be difficult to define. Robinson on Patents, § 144, et seq. It becomes more difficult when a definition is attempted of a function of an element of a combination which are the means by which other elements are connected and by which they coact and make complete and efficient the invention. But abstractions need not engage us. The claim is not for a function, but for mechanical means to bring into working relation the folding plate and the cylinder. This relation is the very essence of the invention, and marks the advance upon the prior art. It is the thing that never had been done before, and both the lower courts found that the machines of the Continental Company were infringements of it.”

Near the bottom of page 23, Defendants propose to add the folders 101 of Hesser to the Beyer machine. There is no evidence whatsoever to the effect that such an alteration is possible without invention. It should be evident to a layman that a folder taken from a machine intended to manufacture square bags with interfolded bottoms could not be introduced into a machine intended to make a flat bag about a flat plate or mandrel, without building an entirely new machine. This would be the function of an inventor, rather than a mechanic.

On pages 24 and 25 of their brief, Defendants argue that claim 3 is invalid because its only distinctive feature is expressed in broad language. In this connec-

tion they cite *Davis Sewing Machine Co. v. New Departure Mfg. Co.*, 217 Fed. 775 (C.C.A. 6, 1914). In that instance the Court was distinguishing the character of the claims under consideration, from certain prior decisions, particularly *Westinghouse v. Boyden*, 170 U.S. 537. The Court first pointed out that in the *Westinghouse* case the claim merely covered an abstract idea, whereas the real invention was a particular type of auxiliary valve used in conjunction with other parts.

Immediately following the quotation cited by Appellees on pages 24 and 25 of their brief, the Court continued its comments with respect to the patent claims, as follows (p. 782):

“* * * But where used with reference to the make-up of the field in which the real invention finds its usefulness or with reference to the connecting parts which permit the salient novelty of the invention to accomplish its function, these words are only a convenient formula of the broadest equivalency of which the real invention permits. Their use amounts to a statement by the inventor that, as to this element, the claim is not confined to the form shown, nor to any close imitation of that form, but extends as broadly as is consistent with the extent of his inventive step to all forms accomplishing that part of the ultimate, composite result, and, of course, does not, of itself, prevent the court (where the state of the record requires) from interpreting the claim as limited to a more or less close approximation to the ‘means’ described in the specification.”

The claims considered by the Court in the *Davis Sewing Machine Co.* case were held valid and in-

fringed. They covered the so-called "Townsend's Coaster Brake" which was an improved coaster brake over prior devices. The Court found that the real novelty of the patent claim was "in his creation of this connector, movable to the right and left inside the hub, clutching the hub at one end of its travel, at the other end of such motion clutching the brake mechanism, and, in its intermediate position, clutching neither". One of these claims of this patent read as follows:

"19. In a bicycle, the combination with a wheel hub and axle, of a brake mechanism, a driver for the hub and brake mechanism, a rotatable sleeve connected with the driver and mounted upon the axle within the hub, a laterally shiftable, rotatable sleeve mounted upon the sleeve of the driver and having tapered portions, a complementary spiral connection between said sleeves, and tapered clutch elements carried by the hub and brake mechanism with which the tapered portions of the shiftable sleeve may engage, substantially as described."

In general, the type of the above claim is substantially the same as the claims of the patent now in suit (Tr. pp. 336 to 338).

SPECIFIC CLAIMS—CLAIM 5.

Beginning at the middle of page 25, Defendants discuss claim 5. This claim is grouped with claim 2 in Plaintiff's opening brief (see page 21). Therefore, the same argument applies as set forth on pages 11 to 14 inclusive of this brief.

SPECIFIC CLAIMS—CLAIM 8.

Commencing on page 26 of Defendants' brief, they treat claim 8, and simply state that this claim is similar to claim 2, and that the end folding member defined by this claim is similar to that of Beyer.

Appellant's opening brief deals with claim 8 beginning near the middle of page 28.

In contending that Gaubert's end folding device has an action similar to the folding plate L of Beyer, the Defendants are again arguing contrary to the evidence in this case. As pointed out in Plaintiff's opening brief (pp. 29-30), the plate L of Beyer which performs the end folding operation simply slides in a straight line over the end of the mandrel or plate B.

On pages 29 and 30 of Plaintiff's opening brief, it is carefully pointed out that the folding or gripping bar 74 shown in Figure 9 of the Gaubert patent, and in detail in Figure 4 (Tr. pp. 320, 322) has an action quite different from the sliding plate of Beyer. The Gaubert end folding bar moves upwardly and over the forward edge of the mandrel, after which it is moved downwardly toward the mandrel in order to complete the fold. Plaintiff's brief also points out advantages to this arrangement (pp. 29 and 30).

An examination of Plaintiff's Exhibit 20 (Tr. p. 363) will give a better understanding of this action, as incorporated in the Defendants' machine. Note that the folding member D, to carry out an end folding operation, moves upwardly, then over the forward end edge of the mandrel, and then downwardly

to complete the fold. This exhibit put in evidence to illustrate the testimony of Plaintiff's Expert, Mr. Kercher (Tr. p. 245), was not controverted or rebutted by Defendants. Certainly mechanism of this type is entirely different from the sliding folding plate of Beyer, and no evidence supports Defendants' contention that it is anticipated by Beyer.

SPECIFIC CLAIMS—CLAIM 14.

Commencing on page 26 of Defendants' brief, claim 14 is considered in detail, and it is argued that the claim is unpatentable over the prior art, and is valid as being for the mere function of a machine.

Appellant adequately dealt with claim 14 commencing on page 31 of his opening brief. Even assuming for the sake of argument that heat sealing is a substitute for glueing or pasting to form a seam, the prior art does not teach a definite method for applying heat sealing in the manufacture of a flat bag, as defined by claim 14. As Plaintiff pointed out in his opening brief, the method of claim 14 avoids heating of single thickness of moistureproof cellophane, such as would destroy the desired moistureproof properties of the finished bag (Tr. p. 310). Likewise it has been pointed out that the finished bag resulting from the method of claim 14 is not the bag of Beyer, even though Beyer should attempt heat sealing, because if the Beyer machine is workable at all, it must be used on a sheet of material having cutaway corners with only a tab for forming the bottom of the bag (Tr. p. 269).

Defendants' attack upon method claim 14 to the effect that it merely describes the function of the machine and is therefore unpatentable, is contrary to well settled law. In fact, this view is controverted by the case cited with approval by Defendants, namely *Expanded Metal Company v. Bradford*, 214 U.S. 366. In that instance the Court sustained as valid a method claim to the procedure employed in the manufacture of so-called "expanded metal". Speaking of the general patentability of such methods, the Court stated as follows (p. 385):

"We therefore reach the conclusion that an invention or discovery of a process or method involving mechanical operations, and producing a new and useful result, may be within the protection of the Federal statute, and entitle the inventor to a patent for his discovery."

The same Court (p. 383) quoted with approval from Robinson on Patents, Vol. 1, Article 167:

"That a process may be patentable, irrespective of the particular form of the instrumentalities used, cannot be disputed. . . . Either may be pointed out; but if the patent is not confined to that particular tool or machine, the use of the others would be an infringement, the general process being the same."

The record shows that the combination of steps defined by claim 14 is not limited to a particular machine. Plaintiff's expert Mr. Kercher pointed out that the steps of claim 14 can be carried out by hand as well as the particular machine shown in the Gaubert patent. Mr. Gaubert also demonstrated how he could

make bags from his manually operated model plaintiff's Exhibit 3 (Tr. p. 90). The fact that the claim calls for a mandrel in carrying out the method is of no moment, because the mandrel is only a simple instrumentality and not a complete working machine.

SPECIFIC CLAIMS—CLAIM 18.

On pages 28 and 29 of Defendants' brief, claim 18 is separately treated. Plaintiff's opening brief deals with this claim on page 23. Defendants do not answer Plaintiff's arguments with respect to this claim, other than to repeat their contentions previously made in connection with claim 2.

SPECIFIC CLAIMS—CLAIM 19.

Defendants consider this claim separately on page 29 of their brief. Plaintiff dealt with this claim in conjunction with claims 2, 5, and 18, commencing on page 21 of their opening brief. Therefore, further comments are unnecessary.

INFRINGEMENT.

Under the heading of "Infringement in General", Plaintiff's opening brief (p. 43) points out that the findings and conclusions of law make no statement concerning infringement.

The trial Court was undoubtedly convinced that Plaintiff had sustained the burden of showing in-

fringement. This is strongly indicated by the fact that customary procedure was not followed in submitting briefs before the lower Court. Instead of requiring Plaintiff to submit an opening brief, with the privilege of filing a closing brief after Defendants' reply, Defendants were required to file both opening and closing briefs (Tr. p. 314).

In addition to the above, the lower Court ordered each party to pay its own costs, thus indicating that Plaintiff would have prevailed except for the Court's attitude in refusing to accept validity of the patent grant.

On page 30, Defendants' brief argues lack of infringement by contending that Plaintiff's exhibits 4 and 6 are not fairly representative of the Gaubert patented machine. This contention is without merit. Gaubert testified that his Exhibit 4 contained certain additions not described in the patent in suit, particularly the attachment for mounting a roll of cellophane, and for cutting off sheets of cellophane to be made into separate bags (Tr. pp. 71-4). He pointed out that otherwise the machine was substantially the same as the machine shown in the patent in suit. No charge of lack of utility can be made for the machine without such attachments, particularly when Defendants Charles and Ira Schultz admit commercial use of such a machine in their establishment (Tr. p. 113).

As clearly pointed out to the Court, Exhibit 6 was offered in evidence in order to complete a showing with respect to the commercial activities of Plaintiff under the Gaubert patent (Tr. p. 80). Plaintiff's expert Mr. Kercher pointed out that Exhibit 6 embodies

the invention of the patent in suit (Tr. p. 187). This was not specifically rebutted by Defendants.

On page 32 of Defendants' brief, the inference is made that Plaintiff's Exhibit 6 was copied or patterned after the Defendants' machine. It will be presently pointed out that there is no substantiation of this charge.

On pages 32 and 33 of Defendants' brief, it is argued that Defendants' machine is more similar to the Beyer patent than to the Gaubert machine, and that the Schultz machine is a different organization than the machine of the patent in suit. This argument is based primarily upon the fact that the machine shown in the patent in suit operates upon separate sheets of material introduced manually into the machine, while the Defendants' machine works upon a continuous sheet of material withdrawn from a roll and is fully automatic. Plaintiff freely admits such differences between the machines, but submits that all of these differences are clearly embraced within the clear scope of the patent claims.

Defendants infer that they have originated the idea of an automatic feed from a continuous roll of material over a rear extension of the mandrel. This is contrary to the record. Actually Plaintiff's expert, Mr. Kercher, pointed out that use of such a continuous feeding from a roll of material was old in the prior art (Tr. pp. 255-256).

The differences between Defendants' machine and the patent in suit outlined on page 34 of Defendants' brief are dealt with in Plaintiff's opening brief, with

the possible exception of the statement that in the Defendants' machine there is no "end folding over the end edge of the mandrel". This contention is totally contrary to the evidence of record. Plaintiff's Exhibit 20 (Tr. p. 363) which shows Defendants' end folding mechanism and indicates its mode of operation, makes clear that the end fold is over the end edge of the mandrel. The accuracy of this drawing was not questioned by Defendants. Certainly Defendants cannot argue that simply because the fold line retaining bar F of Plaintiff's Exhibit 20 at one limit of its movement has one edge extending slightly beyond the near edge of the mandrel, the fold is not over the end edge of the mandrel. This is mere quibbling without a real difference.

Regarding movement of the mandrel referred to on page 34 of Defendants' brief, note that this feature of Defendants' machine was clearly established by the evidence. Initially Defendants' expert, Charles F. Schultz, when called for cross examination, testified that the mandrel on his machine did not move during operation of the machine (Tr. pp. 122-3). This was controverted by the testimony of Mr. Kercher, and the correctness of Mr. Kercher's testimony was demonstrated to the Court by slow motion moving pictures (Tr. pp. 187-190). The Court expressed itself as being satisfied with this demonstration (Tr. p. 190). In both instances the mandrel moves in order to free the underlying sheet of cellophane, so that this cellophane can be moved with respect to the machine.

Beginning on page 35, Defendants argue that the claims in suit do not read upon their machine. First

they contend that all of the claims, excepting claim 18, call for side and end folding "over the mandrel", and that this language confines the claims to a side folding over the same part of the mandrel upon which the heater is subsequently pressed. Clearly this is simply quibbling as to terminology. In the Defendants' machine, the folding is over a rear part or extension of the mandrel (Tr. p. 141). The claims are concerned with the inclusion of means capable of carrying out folding of the side margins of the sheet through 180°, to a position on top of the flat mandrel, in preparation for the end folding and heat sealing operations. This is all pointed out by the testimony of Plaintiff's expert, Mr. Kercher, who also points out equivalency with respect to the side folding means (Tr. pp. 176-177).

In addition, beginning with page 35, Defendants again argue that their machine does not provide an end fold "over the end edge of the mandrel". In this connection attention is directed again to Plaintiff's Exhibit 20, which shows how their machine folds over the end of the mandrel.

GENERAL EQUIVALENCY OF THE PATENTED MACHINE AND THE DEFENDANTS' MACHINE.

Beginning on page 39, Defendants' brief argues that irrespective of the terminology of the claims, Defendants' machine is substantially different in many respects from the machine of the Gaubert patent, and that for this reason infringement cannot be made out.

What Defendants have totally ignored is that the claims of the patent in suit are clear and unambiguous and are in broad language. It has been repeatedly held by this Court that the claims of a patent serve to measure the patented invention (*Rhinehart's, Inc. v. Caterpillar Tractor Co.*, 85 Fed. (2d) 628 (CCA 9, 1936) at page 635).

When a defendant argues for lack of infringement, because of differences between his machine and the machine of the patent, in the face of clear and unambiguous claims which read upon his structure, it is certainly incumbent upon him to show that his interpretation of the claims is either warranted by the history of the patent during its prosecution before the Patent Office, or is necessary to save the claims from invalidity because of the state of the prior art. Defendants have made no effort to show that Plaintiff's interpretation of the claims in suit is inconsistent with the history of the patent in the Patent Office, as shown by the complete file wrapper of record.

If Defendants are proposing to have this Court limit the scope of the claims in view of the prior art, in order to save them from invalidity, then Defendants should be able to show that they are using the teachings of the prior art, rather than the teachings of the patent in suit. Since Defendants cannot so justify their acts, their arguments amount simply to a general attempt to discredit and belittle the subject matter for which the patent was admittedly granted by the Patent Office.

The full automatic feature of Defendants' machine as stressed on pages 39 and 40 of their brief cannot avoid infringement. In this connection note that not a single claim of the patent in suit is limited to manual insertion of the material or manual removal of the finished bag. The machine shown and described in the patent is to be taken as illustrating one embodiment of the invention by means of which the invention can be practiced. At that time Gaubert preferred a semi-automatic cycle of operation, which necessarily involved some labor. However, the invention is clearly broader than this specific form.

On page 51 of Plaintiff's opening brief, reference was made to *Lakewood Engineering Co. v. Walker*, 23 Fed. (2d) 623 (CCA 6, 1928) and *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 Fed. 116, 123 (CCA 7, 1905), as good authority for Plaintiff's contention that infringement is not escaped by making the functions of a machine automatic. It is worth noting that Defendants have cited no authorities contrary to the Lakewood and Columbia Wire Co. cases, and therefore the doctrine of these cases should be accepted as good law.

In discussing the law as to equivalency on page 41 of their brief, Defendants infer that to be a pioneer invention, one must be the first in his field, and that only pioneer inventions are entitled to a range of equivalency. This is not the law. The Supreme Court has repeatedly stated that an inventor need not be a pioneer in order to be accorded a reasonable range of equivalents (*Bundy Mfg. Co. v. Detroit Times Reg-*

ister Co., 94 Fed. 524, CCA 6, *Eibel Process Co. v. Minn. and Ontario Paper Co.*, 261 U.S. 45). It is true that the range of equivalents may be broadened in accordance with the pioneer character of the invention, as for example to ignore specific limitations recited in the claims of a patent.

In the present instance there are no limitations expressed in the claims which need be ignored by the Court. While Gaubert was not the first in the field of bag making machines, he was a pioneer with respect to machines of a certain type, namely machines suitable for the food industry, so that the food industry might successfully make their own bag requirements from moistureproof cellophane. This is pointed out in detail in Plaintiff's opening brief, under the heading of "Other Facts Pertinent to Validity", and "History of Development by Gaubert, Commercial Success, Supplying of Need" (pp. 37 to 48, incl.).

Even Defendants paid tribute to Plaintiff's pioneering by purchasing and using two of Gaubert's machines in their establishment, and in endorsing these machines as highly satisfactory in a letter of recommendation (Ex. 5, Tr. p. 337).

ALLEGED CONTRIBUTION MADE BY DEFENDANTS.

Defendants' comments under this heading on page 44 of their brief are clearly unwarranted as previously pointed out. There is no evidence with respect to any contribution to the art made by Defendants. Gaubert testified that a full automatic cellophane bag machine

(Wrap-Aid machine) appeared on the market in 1936 (Tr. pp. 100, 101) which was after Gaubert's invention but before Defendants' machine. Documentary evidence on this point was objected to by Defendants as being immaterial to the issue of infringement (Tr. pp. 101, 102). Plaintiff's expert, Mr. Kercher, testified (Tr. pp. 255, 256) that it was not new in the art to provide a roll from which a sheet of material is continuously fed for the making of bags, with continual folding of the material.

In addition to the above, the mere incorporation of improved features in a machine does not avoid infringement, and is immaterial in determining infringement of patent claims.

Walker on Patents, Deller's Edition, p. 1693:

"Addition to a patented machine or manufacture does not enable him who makes, uses, or sells the patented thing with the addition, to avoid a charge of infringement (citing cases)."

Beginning on page 45 of their brief, Defendants call attention to alleged lack of interchangeability of parts, as evidence of lack of infringement. In the application of this test, it is not fair to simply take a mechanism in its specific form as embodied in the machine of the patent, and attempt to physically fit it into the Defendants' machine to take the place of a corresponding part. It is well known that parts of modern day machines are not freely interchangeable. For example, the crank shaft of a Ford automobile cannot be used in an automobile of another make, al-

though the function is the same. Interchangeability must, therefore, be considered in a general sense, with primary regard to the functions of the elements which one proposes to exchange. Mr. Kercher in his testimony pointed out such general interchangeability with respect to the side folding means, the end folding means, the fold line retaining means, the mandrel, and the heat sealing heater (Tr. pp. 136 to 150).

On page 47 of their brief, Defendants make the statement that the heaters are not interchangeable, because the Gaubert heater does not have a gap to accommodate the Schultz fold line retaining member. However, the record clearly shows that the Schultz heater, with this gap, can be used upon Plaintiff's Exhibit 4, with cycling of the machine upon two sheets of material (Tr. pp. 304-305).

**DEFENDANTS' PENDING APPLICATION IS NOT
MATERIAL TO THE ISSUE OF INFRINGEMENT.**

Commencing on page 47 of their brief, Defendants call attention to their pending patent application Defendants' Exhibit I (Tr. p. 531), and they argue that this raises a presumption of non-infringement.

A careful analysis of the cases cited by the Defendants will reveal that these cases were decided primarily upon showings in the prior art. The weight of authority is that whether or not a defendant manufactures under a later issued patent (or allowed claims) is not material to the issue of infringement.

The case of *Kokomo Fence Machine Company v. Kistelman*, 189 U.S. 8, does not apply to the facts of this case, because the Court in that instance properly based its conclusions primarily upon the fact that there was little, if any, novelty over the prior art. Also, that during prosecution of the patent in the Patent Office, broad claims were presented which were rejected by the Patent Office, and subsequently cancelled from the application. These were the controlling facts for the Court's decision.

The case of *Dalton Machine Co. v. Rockford Milling Machine Co. et al.*, 253 Fed. 187, likewise does not apply. The primary basis for the Court's decision was the closeness of the prior art disclosures. This decision was affirmed on appeal (267 Fed. 422, CCA 7, 1920), and the Circuit Court's decision was based solely upon the prior art, with no mention being made of the presumption referred to by the lower Court.

The case of *Gerrity et al. v. Dallas Foundry*, 4 Fed. (2d) 655, likewise does not apply. Here, again, the primary basis of the decision was the state of the prior art and the cancellation of broad claims in the Patent Office during prosecution of the patent in suit. The claim of the patent in this instance was so detailed as to call for a diametrical rib attached to the under side of a feeder box lid.

The cited case of *Edwards v. Johnston Formation Testing Corp., et al.*, 44 Fed. (2d) 607, is a District Court case, Southern District of Texas, Houston Division. Here, again, the controlling basis of the deci-

sion was the state of the prior art and the fact that the invention disclosed little, if anything, of novelty over the prior art.

Note that the Schultz application is not an issued patent, and that the allowance of claims in a patent application is not equivalent to the granting of claims. The allowance of a claim in an application can be revoked at any time. It is subject to priority (interference) contests within the Patent Office where two or more parties claim the same invention.

The weight of authority is that whether or not a defendant manufactures under a later issued patent (or allowed claims) is not material to the issue of infringement.

Bake-Rite Mfg. Co. v. Tomlinson et al., 16 Fed. (2d) 556 (CCA 9), 1926 (p. 559);

Jonas et al. v. Roberti et al., 7 Fed. (2d) 563 (CCA 9, 1925) (p. 564);

Walker on Patents, Deller's Edition, Volume Three, p. 1758;

Sanitary Refrigerator Company v. Winters, 280 U.S. 30 (1929), p. 43.

ADDITIONAL CONSIDERATIONS ON THE QUESTION OF INFRINGEMENT.

Considering generally the differences between the machine of the Gaubert patent and Defendants' Exhibit A, aside from the fact that one is automatic and the other is semi-automatic, there are certain admitted

differences in timing and cycling. For example, the side fold on the Defendants' machine is commenced on the rear mandrel extension, and completed as the cellophane is drawn underneath the region of the sealing heater. When the heater moves downwardly, it simultaneously performs an end and a longitudinal sealing operation, but a part of the longitudinal sealing operation may be on a piece of material which forms a part of the next bag. The same cycling can be carried out with the machine of the Gaubert patent, as actually demonstrated to the Court by Mr. Gaubert on Plaintiff's Exhibit 4 (Tr. pp. 304-5). Differences of this character are variations within the scope of the patent claims, and do not depart from primary invention.

With respect to method claim 14, a variation in the sequence of steps of a method does not avoid infringement of a patent.

Walker on Patents, Deller's Edition, Volume Three, p. 1737:

“* * * Neither is infringement avoided by merely reversing the steps in the process, when the same result is accomplished in substantially the same way (*Burdon Wire & Supply Co. v. Williams*, 128 Fed. 927 (1904); *Wolff et al. v. E. I. Du Pont de Nemours & Co.*, 134 Fed. 862, C.C.A. 3; *Malignani v. Germania Electric Lamp Co.* (Citing numerous cases), 169 Fed. 299 (1909); *General Electric Co. v. Hill-Wright Electric Co.*, 174 Fed. 996, 999, C.C.A. 2; *Malignani v. Hill-Wright Electric Co.*, 177 Fed. 430 (1910); *Chadeloid Chemical Co. v. F. W. Thurston Co.*, 220 Fed. 685 (1915).”

Matrix Contrast Corporation v. Kellar, 34 Fed. (2d) 510 (CD NY) 1929.

“The variation of the order of steps does not avoid infringement (Citing cases).”

Los Angeles Lime Co. et al. v. Nye, 270 Fed. 155 (CCA 9, 1921), p. 158.

“The view taken by the trial Court respecting the question of infringement as stated in the record was that any change in the order of the steps as designated in the patent operated an avoidance of infringement; but we do not so understand the law.”

The same doctrine applies to apparatus claims of a patent, where a defendant endeavors to avoid infringement by making modifications which change the location or sequence of operation of the elements.

Los Angeles Lime Co. et al. v. Nye, 270 Fed. 155 (CCA 9, 1921), at 160.

“Even in combination patent a change in the form or the location or sequence of the elements of the patent will not avoid infringement where they are all employed to perform the same functions, unless form, location, or sequence is essential to the result or to the novelty of the claim. *Adam v. Folger*, 120 Fed. 260, 56 C.C.A. 540. See, also, *Malignani v. Hill-Wright Electric Co.* (C.C.) 177 Fed. 430; *Rodman v. Deeds Commercial Laboratories* (C.C.A.) 261 Fed. 190, 191; *Pedersen v. Dundon*, 220 Fed. 309, 136 C.C.A. 143; *Bliss v. Spangler*, 217 Fed. 399, 132 C.C.A. 210; *Williams v. Kaufmann*, 259 Fed. 859, 170 C.C.A. 659.”

Concerning the fact that the Defendants' machine contains some elements, as for example the mounting of the roll of cellophane, which the machine of the Gaubert patent does not possess, note that the addition of elements to a patented combination does not avoid infringement.

Walker on Patents, Deller's Edition, Volume Three, p. 1693.

"Addition to a patented machine or manufacture does not enable him who makes, uses, or sells the patented thing with the addition, to avoid a charge of infringement. (*Western Electric Co. v. La Rue*, 139 U.S. 601 (1891); *Western Electric Co. v. Capital Tel. & Tel. Co.*, 86 Fed. 796 (1898); *Newton v. McGuire*, 97 Fed. 614 (1899); 1900 *Washer Co. v. Cramer*, 169 Fed. 629 (1909); *Stebler v. Riverside Heights Orange Growers' Assn.*, 205 Fed. 735, C.C.A. 9.)"

(p. 1694):

"* * * This is true even where the added device facilitates the working of one of the parts of the patented combination, and thus makes the latter perform its function with more excellence and greater speed. *Cochrane v. Deener*, 94 U.S. 780 (1877); *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 Fed. 116 (1905);"

**THE PRIOR ART RELIED UPON BY THE DEFENDANTS
SHOWS NEITHER ANTICIPATION NOR LACK OF
INFRINGEMENT.**

In their conclusions appearing on pages 53 and 54 of Defendants' brief, they summarize their belittling attitude toward the invention in suit, and make reference to a considerable number of the prior art patents as showing various features of the patented device.

The claims of a patent cannot be anticipated and invalidated simply by finding at random in the prior art various features and elements which are incorporated in the patented structure. Obviously mechanical parts such as heaters, folding devices, forming mandrels, and the like can be found scattered through a wide variety of prior art disclosures. However, when an inventor assembles certain of these elements into a new working machine, capable of new and important results, a patentable invention is formed which cannot be invalidated simply by pointing to the possible origin of the separate elements. This is because the assembly of old elements forms a new machine of itself, or in other words, the combination assumes a separate entity. Walker on Patents, Deller's Edition, p. 215.

In his opening brief, Plaintiff referred to the difference between the creation of an invention such as forms the proper subject matter of a patent grant, and the field of mechanical or engineering skill, which is not subject to patent protection. Possibly a better understanding of this distinction can be had by considering how an inventor might proceed to develop a new invention, as distinguished from the work of a me-

chanic or engineer in refining a device. Generally an inventor first appreciates the need for a new machine or a device, and then sets about to devise a mechanism which will fulfill this need. If he knows of no prior machines of the general character which he has in mind, he first evolves a mental concept of certain elements working together which may be capable of solving the problem. Then he sets about to evolve mechanism in the form of a complete machine which will embody his concept and which will reduce the invention to practice. If he is aware of a prior machine which has attempted to solve the problem, but which has not been successful, or which has limited application, he may conceive of an improvement to the machine, and he then re-builds the previous machine to incorporate his improvement.

If an ordinary mechanic or engineer is requested to refine a machine to eliminate a defect, or to make the machine applicable for a modified purpose, he will simply seek to use his skill in bettering the design of various parts, without undertaking to develop a new machine.

The history of the Gaubert invention as set forth in Plaintiff's opening brief, pages 38 to 42, makes clear that Gaubert did not simply undertake the work of a mechanic or engineer. He understood the hard and unchartered course of an inventor. He created a new machine by exercise of creative efforts clearly beyond the skill of an ordinary mechanic or engineer. Having made such a creation, it is good public policy

to reward him with a limited patent monopoly for seventeen years.

CONCLUSION.

Plaintiff submits that Defendants' brief fails to justify the decision of the lower Court and fails in its effort to show lack of infringement.

Plaintiff accordingly again submits that the decision of the lower Court should be reversed, and that the lower Court should be directed to hold the patent claims in suit valid and infringed.

Dated, San Francisco,
March 13, 1942.

Respectfully submitted,

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